

REMARKS

Claims 24, 28-38 and 40-49 are pending in this application. By this Amendment, claims 27 and 39 are canceled without prejudice to or disclaimer of the subject recited therein. Claims 24 and 38 are amended to incorporate the subject matter of canceled claims 27 and 39, respectively. Claims 31, 33-36, 43 and 45-48 are amended to correct their dependency. Thus no new matter is added.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration as the amendments amplify issues previously discussed throughout prosecution; and (c) place the application in better form for appeal, should an appeal be necessary. Entry of the amendments is thus respectfully requested.

I. Claim Rejections Under 35 U.S.C. §103

Claims 24, 27-33, 35-45 and 47-49 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,522,421 to Chapman et al. (Chapman) in view of U.S. Patent No. 6,223,029 to Stenman et al. (Stenman) and further in view of U.S. Patent No. 6,173,338 to Fukuta. As claims 27 and 39 are canceled, the rejection of these claims is moot. The rejection of claims 24, 28-33, 35-38, 40-45 and 47-49 is respectfully traversed.

None of the applied references, whether considered alone or in combination, disclose or suggest each and every feature recited in the rejected claims. For example, the combination of references fails to disclose or suggest a control method of controlling an image forming device, comprising the steps of receiving image information from an external device, storing the image information in a memory until receiving an instruction to print, after storing the image information in the memory, outputting to the cellular phone a signal indicating that the image information is stored in the memory, wherein the instruction is

received from the cellular phone after the signal is outputted, receiving the instruction to print the image information from a cellular phone after storing the image information in the memory, and executing printing of the image information in accordance with the received instruction, as recited in amended claim 24.

Further, the combination of references fails to disclose or suggest a printing system, comprising an image forming device including a receiving unit that receives an image information from an external device, an output unit that outputs a signal to a cellular phone after the image information is stored in the memory, a memory in which the image information is stored, a printing unit that executes printing of the image information; and a controller that controls the printing unit to execute the printing, and the cellular phone including a communication unit that transmits an instruction to the image forming device after the image information is stored in the memory of the image forming device, and the communication unit transmits the instruction to the image forming device after receiving the signal output from the output unit of the image forming device, wherein the controller controls the printing unit to execute the printing when the instruction is transmitted from the cellular phone, as recited in amended claim 38.

It is alleged in the Office Action that Chapman discloses "storing the image information in a memory" at col. 3, lines 35-37. However, as previously pointed out in the August 31, 2005 Amendment, Chapman merely discloses that "a program stored in memory in the printer for detecting embedded e-mail information is provided in the Appendix" (emphasis added). More specifically, Chapman merely relates to a method of automatically returning status and error information from a printer using e-mail. In the method of Chapman, the printer receives a file and begins interpreting the page description language. It also detects an embedded e-mail and it tracks the e-mail address using a program stored in the memory of the printer. Thus, Chapman fails to disclose or even suggest the feature of storing

image information in a memory. Accordingly, Chapman fails to disclose the claimed feature as alleged in the Office Action.

It is also admitted in the Office Action that Chapman fails to disclose receiving an instruction to print the image information from a cellular phone. In an effort to overcome the admitted deficiency, it is alleged that Stenman discloses such a feature. However, in making the allegation that Stenman discloses this feature, the Office Action fails to provide a complete recitation of the claim feature, but rather merely parses the claim feature into fragments of component parts in an effort to obtain a reference showing the newly configured claim language. The Office Action appears to recognize this shortcoming and goes on to further combine the teachings of Fukuta to provide the feature subsequently admitted as being missing from Stenman. Specifically, it is alleged in the Office Action that Fukuta teaches "receiving an instruction to print the image information after storing the image information in the memory."

By parsing the subject matter of the claims as in the outstanding Office Action, consideration of the claimed invention "as a whole" is not being conducted. 35 U.S.C. §103 specifically requires consideration of the claimed invention "as a whole." The "as a whole" instruction prevents evaluation of the invention on a part-by-part basis. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. *In re Ruiz v. AB Chance Co.*, 357 F.2d 1270, 1275 (Fed. Cir. 2004). Additionally, the "as a whole" assessment of the invention requires a showing that one of ordinary skill and the art of the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in

the claimed manner. In other words, §103 requires some motivation or suggestion before the invention itself to make the new combination. *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998). As the claimed invention is being parsed into its component parts and the features being further parsed or fragmented in an effort to find corresponding prior art, a *prima facie* case of obviousness has not been established.

Moreover, even were such a combination made, the resulting combination of references fails to disclose each and every feature recited in the rejected claims as amended. None of the applied references, whether considered alone or in combination disclose outputting to the cellular phone a signal indicating that the image information is stored in the memory, after storing the image information in the memory and wherein the instruction is received from the cellular phone after the signal is outputted.

For example, it is admitted in the Office Action that Chapman as modified by Stenman fails to disclose that after storing the image information to the memory a signal is outputted to a device indicating that the image information is stored in the memory. In an effort to overcome this admitted deficiency the Office Action again combines Fukuta for allegedly disclosing the claimed feature. In support of the rejection, the Office Action recites col. 7, lines 25-33 and col. 16, lines 59-67 of Fukuta. Column 7, beginning at line 25, describes that when a digital color copying machine 120 is powered on, it is set to a ready state. The digital color copying machine 120 then determines whether or not it has received a notice of image management information from the image processing apparatus 110. If a notice of image management information has been received, it is assumed that the image data to be printed is stored in the image memory in the image processing apparatus 110. Thus, the first referenced section of Fukuta fails to disclose or suggest that after storing the image information in the memory, a signal is outputted to a cellular phone indicating that the image information is stored in the memory.

Further, the referenced section of col. 16, beginning at line 56, merely recites claim 8 of Fukuta which includes "enabling input of image data and a print condition regarding a printing form of said image data; enabling storage of the image data in a memory; enabling output of the image data stored in the memory to a printer for printing an image based on the image data; enabling entry of the print condition regarding the printing form for causing the printer to print the image and of an instruction for beginning the output of the image, after the image data has been input and stored in the memory; enabling the selection of one of either a first print mode or a second print mode, wherein print of the image is begun in accordance with the print mode so selected, wherein selection of the first print mode sets the print condition regarding the printing form input in the inputting step is changeable input pursuant to said entry, and selection of the second print mode causes completion of the print of image based on the print condition regarding the printing form input in the inputting step even if nothing is entered pursuant to said entry." Thus, it is readily apparent that Fukuta fails to disclose sending any signal whatsoever to the cellular phone indicating that the image information is stored in the memory, after storing the image information in the memory, wherein the instruction is received from the cellular phone after the signal is outputted.

As none of the applied references, whether considered alone or in combination, disclose or suggest each and every feature recited in the rejected claims as amended, withdrawal of the rejection of claims 24, 27-33, 35-45 and 47-49 is respectfully requested.

Claims 34 and 46 are rejected under 35 U.S.C. §103(a) as unpatentable over Chapman in view of Stenman and Fukuta and further in view of WO 94/26059 to Peyser. The rejection is respectfully traversed.

Claims 34 and 46 are allowable for their dependency on their base claim for the reasons discussed above, as well as for the additional features recited therein. Accordingly,

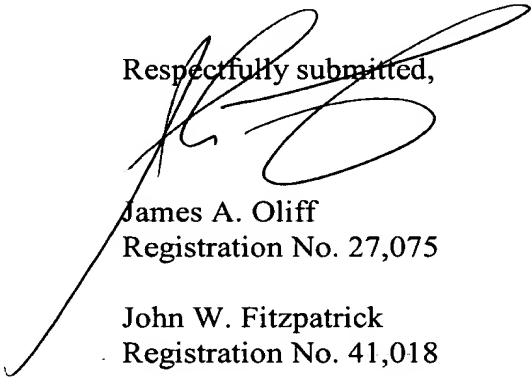
withdrawal of the rejection of claims 34 and 46 under 35 U.S.C. §103(a) is respectfully requested.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,


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